

REMARKS:

Claims 1-31 are currently pending in the application.

The Specification stands object to for certain informalities.

Claims 32-50 are currently canceled without *prejudice*.

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,957,199 B1 to Fisher ("*Fisher*").

Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of U.S. Publication No. 2002/0040352 to McCormick ("*McCormick*").

SPECIFICATION OBJECTION:

The Specification stands object to for certain informalities.

Specifically, the Examiner asserts that independent "the abstract is in excess of 150 words." (21 March 2007 Office Action, Pages 2-3). In response the Applicants have amended the Abstract.

The Applicants respectfully submit that the Abstract is not in excess of 150 words. Thus, the Applicants respectfully request that the objection to the specification be reconsidered.

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 102(e) over *Fisher*.

The Applicants respectfully submit that *Fisher* fails to disclose each and every limitation recited by Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31. The Applicants further submit that Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 patentably distinguish

over *Fisher*. Thus, the Applicants respectfully traverse the Examiners rejection of Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 under 35 U.S.C. § 102(e) over *Fisher*.

Fisher Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to independent Claim 1, this claim recites:

A system for facilitating negotiation of a standard for inter-enterprise collaboration between trading partners, comprising:

a ***set of one or more meta-model elements*** each capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-model that describes an agreement between the enterprises as to collaborations between the enterprises, each meta-model element in the set describing a portion of a potential standard for collaboration between enterprises;

a meta-model negotiation service operable to:

receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the enterprises;

provide access to the set of meta-model elements;

receive selections of one or more of the meta-model elements for negotiation and incorporation into a negotiated meta-model, the negotiated meta-model describing an agreement between the enterprises as to collaborations between the enterprises;

facilitate negotiation of the selected meta-model elements;

incorporate negotiated meta-model elements into the negotiated meta-model for collaborations between the enterprises; and

communicate the negotiated meta-model to the enterprises to enable collaborations between the enterprises according to the standard for collaborations reflected in the negotiated meta-model. (Emphasis Added).

Independent Claims 11, 21, and 31 recites similar limitations. *Fisher* fails to disclose each and every limitation of independent Claims 1, 11, 21, and 31.

The Applicants respectfully submit that *Fisher* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “***system for facilitating negotiation of a standard for inter-enterprise collaboration between trading partners***”. In particular, the Examiner equates the “***system***” recited in independent Claim 1 with the ***system*** disclosed in *Fisher*. (21 March 2007 Office Action, Page 3). However, ***the system disclosed in Fisher*** is merely provided for facilitating secure interaction between

trusted users, but **does not include, involve, or even relate to the system**, as recited in independent Claim 1. (Column 12, Lines 10-16). In contrast, “**system**” recited in independent Claim 1 **is provided for facilitating negotiation of a standard for inter-enterprise collaboration between trading partners**. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Fisher* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Fisher*.

The Applicants further respectfully submit that *Fisher* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “**set of one or more meta-model elements** each capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-model that describes an agreement between the enterprises as to collaborations between the enterprises, each meta-model element in the set describing a portion of a potential standard for collaboration between enterprises”. In particular, the Examiner equates the “**set of one or more meta-model elements**” recited in independent Claim 1 with the **documents** disclosed in *Fisher*. (21 March 2007 Office Action, Page 3). However, **the documents disclosed in Fisher** are not meta model elements, readable by collaboration software or even a set of one or more meta model elements, as recited in independent Claim 1. (Column 37, Lines 45-49). In contrast, the “**set of one or more meta-model elements**” recited in independent Claim 1 are each capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-model that describes an agreement between the enterprises as to collaborations between the enterprises, each meta-model element in the set describing a portion of a potential standard for collaboration between enterprises. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Fisher* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Fisher*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Fisher*

The Applicants respectfully submit that the allegation in the present Office Action that *Fisher* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Fisher* is considered to anticipate all of the limitations in Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

The Applicants respectfully point out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 under 35 U.S.C. § 102 with respect to Fisher because Fisher fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claims.***

The Applicants Claims are Patentable over *Fisher*

With respect to independent Claims 11, 21, and 31 these claims includes limitations similar to those discussed above in connection with independent Claim 1. Thus, independent Claims 11, 21, and 31 are considered patentably distinguishable over *Fisher* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2, 3, 6-10, 12, 13, 16-20, 22, 23, and 26-30: Claims 2, 3, and 6-10 depend from independent Claim 1; Claims 12, 13, and 16-20 depend from independent Claim 11; and Claims 22, 23, and 26-30 depend from independent Claim 21 are also considered patentably distinguishable over *Fisher*. Thus, dependent Claims 2, 3, 6-10, 12, 13, 16-20, 22, 23, and 26-30 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants respectfully submit that Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 are not anticipated by *Fisher*. The Applicants further respectfully submit that Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 under 35 U.S.C. § 102(e) be reconsidered and that Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means

known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other

person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of

experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *McCormick*.

The Applicants respectfully submit that *Fisher* or *McCormick*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 4, 5, 14, 15, 24, and 25. Thus, the Applicants respectfully traverse the Examiners obvious rejection of Claims 4, 5, 14, 15, 24, and 25 under 35 U.S.C. § 103(a) over the proposed combination of *Fisher*, *Foley*, or *McCormick* either individually or in combination.

The Office Action Acknowledges that *Fisher* Fails to Disclose Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Fisher* fails to disclose various limitations recited in independent Claim 1. Specifically the Examiner acknowledges that *Fisher* fails to teach the “structure of transaction, data elements, state model describing the cycle, accessing that a role type has data elements, or actions that a role type can execute...” and “dimensions with a supply chain element, dimensionalities with a combination of supply chain elements, or temporal structures.” (21 March 2007 Office Action, Pages 13-20). However, the Examiner asserts that the cited portions of *McCormick* disclose the acknowledged shortcomings in *Fisher*. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *McCormick*.

However, based on the Examiner’s admission, that *Fisher* fails to teach *inter alia*, data elements, the Applicants respectfully submit that the Applicants are confused as to what the Examiner asserts that *Fisher* does in fact teach. For example, if *Fisher* fails to teach data elements, as admitted to by the Examiner, then what type of ***meta-model***

elements does the Examiner assert that *Fisher* teaches. The Applicants respectfully request clarification from the Examiner.

The Applicants Claims are Patentable over the Proposed *Fisher-McCormick* Combination

The Applicants respectfully submit that, as discussed above, independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher* or *McCormick*.

Furthermore, with respect to dependent Claims 4, 5, 14, 15, 24, and 25: Claims 4 and 5 depend from independent Claim 1; Claims 14 and 15 depend from independent Claim 11; and Claims 24 and 25 depend from independent Claim 21. As mentioned above, each of independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher* or *McCormick*. Thus, dependent Claims 4, 5, 14, 15, 24, and 25 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 4, 5, 14, 15, 24, and 25 are not rendered obvious by the proposed combination of *Fisher* or *McCormick*. The Applicants further respectfully submit that Claims 4, 5, 14, 15, 24, and 25 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 4, 5, 14, 15, 24, and 25 under 35 U.S.C. § 103(a) be reconsidered and that Claims 4, 5, 14, 15, 24, and 25 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **and not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, **there must be something in the prior art as a whole to suggest the desirability**, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

29 May 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184